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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,054	01/15/2002	Etienne Georges Maze	003744-02	2937

7590

01/27/2006

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EXAMINER
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LAVILLA, MICHAEL E

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/045,054

Applicant(s)

MAZE ET AL.

Examiner

Michael La Villa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 72-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 72-79, 81, 82 and 85-91 is/are allowed.
- 6) ☒ Claim(s) 80, 83, and 84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:
2. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claims 80, 83, and 84 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See the reasons of record in the Office Action mailed on 10 August 2005.
4. Claims 80, 83, and 84 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Omitting limitations critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See the reasons of record in the Office Action mailed on 10 August 2005.

### ***Response to Amendment***

- I. In view of applicant's amendments, applicant traverses the objection to the claims of the Office Action mailed on 10 August 2005. Objection is withdrawn.

- II. In view of applicant's arguments, applicant traverses the section 103 rejection over Guhde of the Office Action mailed on 10 August 2005. Rejection is withdrawn.
- III. In view of applicant's arguments, applicant traverses the section 112, first paragraph new matter and non-enablement rejections of the Office Action mailed on 10 August 2005. Applicant argues that the Specification does not require the presence of silane in applicant's inventive compositions and that the language to which the rejection refers is merely describing preferred embodiment compositions. Applicant refers to chromium containing compositions, silica containing compositions, and titanate polymer containing compositions, all of which may that lack silane, as evidence that there is no requirement for the presence of silane. However, this argument fails to recognize that the Specification teaches various invention "aspects," some of which are directed to silane containing compositions and others that are not so directed. The silane containing compositions are described under the heading of "Chromium-Free Coating Composition" at page 9 of the Specification. Based on the language of the claims and the corresponding technical limitations, Claims 80, 83, and 84 appear to relate to the "aspect" of the invention that relates to these silane containing compositions. The rejection refers to pages 9 and 11 of the

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Specification as teaching that silane is a necessary ingredient for this “aspect” of the invention.

- IV. With respect to the enablement rejection, not only does the Specification teach that silane is a necessary ingredient, at page 11 the binding agent role of silane is disclosed. The presence of silane would cure to form a binding agent under the claimed heat treatment. In the absence of silane, however, it is unclear how the claimed heat treatment would result in a coating that provides corrosion resistance as the metal flakes themselves may not coalesce at such low temperatures. Since the Specification has described the presence of silane as necessary in the claimed context, the claims as presented are not be enabled. Rejection is maintained.
- V. With respect to the new matter rejection, as Claims 80, 83, and 84 do not relate to chromium containing, silica containing, or titanate polymer containing compositions, the fact that those compositions, which relate to other “aspects” of the invention, may lack silane as disclosed in the Specification would appear to be irrelevant. As there appears to be no other disclosure in the Specification or other factual basis for teaching the totality of the claim limitations of Claims 80, 83, and 84, without the presence of silane, no basis for finding antecedent support has been presented. Any such other factual basis would have to overcome the teaching of the Specification that the presence of silane is a necessary

ingredient for the chromium free coating composition "aspect" of the invention. Rejection is maintained.

***Allowable Subject Matter***

5. Claims 72-79, 81, 82, and 85-91 are allowed.

***Conclusion***


6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael La Villa  
23 January 2006



MICHAEL E. LAVILLA PH.D.  
PRIMARY EXAMINER